

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 26-57 were pending in this application when last examined.

Claims 46-49 were examined and stand rejected.

Claims 26-45 and 50-57 are cancelled without prejudice or disclaimer thereto.

Applicants reserve the right to file a continuation or divisional application to any cancelled subject matter.

Claims 46 is amended to recite "An agent for detecting a cancer". Support for this amendment can be found, for example, on page 9, lines 14-20.

Claim 46 is also amended to recite "a peptide having an amino acid sequence designated by SEQ ID NO: 1 or a portion thereof." Support for this amendment can be found, for example, on page 8, lines 11-31, in Example 11 on page 34, in Example 14 on page 36-37 and page 25, lines 3-5, of the specification as filed. Claim 46 is also amended to recite "specifically binds to". Support for this amendment can be found on page 7, lines 25-30, and page 69, lines 12-28, of the specification as filed. Finally, claim 46 is amended to recite "water" as a component of the claimed agent. Support can be found, for example, on page 40, lines 28-32, of the specification as filed.

Dependent Claims 47 and 48 are amended to conform with the changes in Claim 46.

Claims 58-69 are newly added.

Support for claim 58 can be found on page 37, lines 22-28, of the specification as filed. Please note that, as indicated in the attached FERM depository receipt, FERM P-19298 is the provisional deposit number that correlates to deposit number FERM BP-10157. Support for claims 59, 60, 64 and 68 can be found in Example 19 on pages 41-42 of the specification as filed. Support for claims 61, 65 and 69 can be found on page 41, lines 20-25, of the specification as filed. Support for claims 62-63 and 66-67 can be found, for example, in SEQ ID NO: 2 and SEQ ID NO: 3 of the Sequence Listing with

the specification as filed. Further support can be found, for example, on page 7, lines 12-28, and page 8, line 32 to page 9, line 5, of the specification as filed.

No new matter has been added.

II. SEQUENCE LISTING

There is submitted herewith a paper copy of the revised Sequence Listing, together with a disk containing a computer readable version of the revised Sequence Listing. The paper and computer readable versions of the Sequence Listing are identical. No new matter has been added.

The Sequence Listing has been revised to list all nucleotide sequences, composed of 10 or more nucleotides, disclosed in the specification. Such sequences have also been amended within the specification to recite SEQ ID NOs. It is therefore respectfully submitted that the Examiner's objection to the specification for not identifying primer sequences by SEQ ID NOs. should be withdrawn. It is also respectfully submitted that the application is now in compliance with the sequence rules under 37 CFR 1.821-1.825.

III. OBJECTIONS TO THE SPECIFICATION

The specification has been revised to correct grammatical and spelling errors. Furthermore, trademarks disclosed in the specification have been capitalized, properly marked with TM and the generic names given. No new matter has been added.

It is therefore respectfully submitted that the objections to the specification for the above noted reasons should be withdrawn.

IV. INDEFINITENESS REJECTION

On page 3 of the Office Action, claims 46-49 were rejected under 35 USC 112, second paragraph, as indefinite for the term "Mina53 protein". Applicants have amended the rejected claims to recite a SEQ ID NO: for Mina53 protein, as suggest by the Examiner. Thus, Applicants submit this rejection is now untenable and should be

withdrawn.

V. ENABLEMENT REJECTION

On pages 4-6 of the Office Action, claim 49 was rejected under 35 USC 112, first paragraph, as not enabled since the specification did not provide evidence that the claimed hybridoma was known and readily available to the public. Attached herewith is a copy of the FERM depository receipt showing the claimed hybridoma has been deposited under the Budapest Treaty. Applicants agree that FERM BP-10157 will be irrevocably and without restriction released to the public upon issuance of a patent arising from this application claiming FERM BP-10157.

VI. WRITTEN DESCRIPTION REJECTION

On pages 6-7 of the Office Action, claims 46 and 47 were rejected under 35 USC 112, first paragraph, on the basis that the specification lacked written description support for an antibody to a Mina53 protein.

Claims 46 and 47 have been amended to recite an antibody that specifically binds to a peptide having the amino acid sequence of SEQ ID NO: 1 or a portion thereof, an embodiment indicated in the Office action as having written description support. Thus, Applicants submit this written description rejection is now untenable and should be withdrawn.

VII. ANTICIPATION REJECTION

On page 8 of the Office Action, claim 46 was rejected under 35 USC 102(b) as anticipated by Ota et al. (EP 1 074 617 A2). Applicants respectfully traverse this rejection as applied to the amended claims.

Claim 46 as amended is directed toward an agent for detecting a cancer comprising water and an antibody that specifically binds to a peptide having the amino

acid sequence of SEQ ID NO: 1 or a portion thereof. Ota et al. does not teach an agent for detecting cancer comprising water and the claimed antibody. It is therefore submitted that Ota et al. fails to teach each and every element of the claimed invention.

Applicants therefore respectfully submit that the rejection under 35 USC 102(b) is now untenable and should be withdrawn.

VIII. OBVIOUSNESS REJECTION

On pages 9-10 of the Office Action, claims 47 and 48 were rejected under 35 USC 103(a) as being obvious over Ota et al. in view of Campbell (Monoclonal Antibody Technology, Ch. 1, pp. 1-32, 1984).

This rejection is respectfully traversed as applied to amended claims 47 and 48.

Claims 47 and 48 as amended are directed toward an agent for detecting a cancer comprising water and a monoclonal antibody that specifically binds to a peptide having the amino acid sequence of SEQ ID NO: 1 or a portion thereof, and a hybridoma for producing the antibody of said agent. Neither Ota et al. nor Campbell teaches or suggests an agent for detecting cancer comprising water and the claimed antibody. Furthermore, a skilled artisan would not envision an agent for detecting cancer from the teachings of these references. In particular, neither reference teaches SEQ ID NO: 1 is associated with cancer and thus a skilled artisan would not envision detecting cancer by using an antibody against SEQ ID NO: 1 and water. Thus, neither Ota et al. nor Campbell teaches or suggests each and every element of claims 47 and 48.

In view of the above, the rejection of claims 47 and 48 under 35 USC 103(a) as being obvious over Ota et al. in view of Campbell is untenable and should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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April 11, 2007

ATTACHMENTS

1. Receipt for Deposit of Microorganism under the Budapest Treaty for FERM BP-10157
2. Sequence Listing in CRF and paper form
3. Revised Specification (Clean and Marked up copies)
4. Revised Abstract (Clean copy)